

**REMARKS**

In response to the Office Action mailed, June 5, 2006, the above claims have been amended to more clearly claim the invention. No change or modification of scope is intended by such amendments.

Claims 1-130 have been cancelled and new claims 131-152 have been added. The new claims clearly avoid the rejection on the basis of the "Recapture Rule", as will be more explained below. For the convenience of the Examiner, the correspondence between the cancelled claims 107-130 and new claims 131-152 is set forth in *Appendix I*, attached hereto and made a part hereof.

The rejection of claim 130 under 35 CFR 1.75(c) has been overcome by the newly added claim 152.

Withdrawal of the restriction requirement is noted with appreciation.

**Reissue Applications:**

The Examiner has rejected claims 107-130 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Newly added claims 131-152 avoids this rejection for the following reasons.

**I. The recapture rule does not apply to the new claims.**

The present composition claims have never been considered in the prior prosecution of the parent patent. In the prosecution of the parent patent, there was never a claim presented that was free of any limitation with respect to the type of phosphate ester in the claimed composition. The prior claims have consistently been directed to phosphate ester base stock fluids. However, as was stated in the application as filed, the additive package for use in phosphate ester base stock fluids **is novel**. The presently claimed novel additive composition **has never been claimed**. Thus, there was no, nor could there have been, prior amendments of such claims. The fact is that during the prosecution of the parent patent a mistake was made in not claiming an invention the inventors herein had a right to claim. It is the purpose of the present reissue application to correct such mistake. As was noted in In re Michael P. Doyle 293 F3d 1355; 63 U.S.P.Q. 2d 1161 (Fed. Cir. 2002) this is “precisely the reason” the reissue statute was enacted. The statements made in the Preliminary Amendment are repeated here. As in Doyle, the Applicant herein failed to file a genus claim relating to the novel additive package, but continued with the specie claims to the additive package in combination with a specific phosphate ester based hydraulic fluid. Data in the application as filed shows that the additive package was active in a broader scope of hydraulic fluid base stock than was claimed and that the additive package standing alone constituted a novel composition.

More recently, the Federal Circuit has rendered another opinion under circumstances similar to the facts of this application. See Medtronic Inc. v. Guidant Corp. (Fed. Cir., 80 USPQ 2d 1558 October 12, 2006). In that case, the claims of the reissue patent claimed an embodiment

that inadvertently was not claimed in the parent patent. As in the present application, there was no surrender of the claimed subject matter of the reissue application by amendment or argument because such claims were not previously presented. In similar circumstances, the present reissue application contains no **limitations** that were broadened over such limitations surrendered by amendment or argument in the prior prosecution of the parent patent.

It is the position of Applicant that the above two binding precedents are “on all fours” with the present application in that the claims of the reissue application only claims what the inventor had a right to claim in the original prosecution but by inadvertence and mistake did not do so. In the Preliminary Amendment and the two precedents noted above it is stated that the present situation “the patent code was enacted precisely to correct the kind of error that occurred in the prosecution of the application resulting in the patent.” The two binding precedents are compelling with respect to the withdrawal of the rejection based upon “recapture”.

As noted in the Preliminary Amendment, the original application stated that the additive package was “novel”. Thus, although the inventors took note of the fact that the additive package was novel, no claims to the additive package per se were ever made. The present claims are neither broader nor narrower than those granted in the parent patent. Simply stated the claims now presented are to a different invention than was claimed in the parent patent. The only reference to phosphate esters is in the preamble with respect to use only. Accordingly, when properly construed, the present claims do not contain a limitation with respect to a phosphate ester. Furthermore, the Recapture Rule does not apply because the present claims were not surrendered by amendment or argument. On the authority of the cited

cases with respect to recapture, the Examiner is respectfully requested to withdraw the rejection on the basis of recapture.

**II. Proper claim construction of the amended claims provides no basis for a rejection under 35 U.S.C. 251 for impermissible broadening of claims under the recapture rule.**

It is the Applicant's position that the preamble does not constitute, either originally or in this amendment, any limitation on the claimed compositions. Furthermore, there is no need to refer to the preamble for the purpose of understanding the presently amended claims.

Proper claim construction of the presently amended claims requires the conclusion that the preamble does not constitute a limitation of the claimed composition. The presently amended claims do not require a reference to the preamble for any definition or understanding of the claimed compositions. As will be shown below, given proper claim construction, the preamble does not provide any limitation to the claimed compositions. The only decisions that found the preamble to provide a limitation to the claimed subject matter were in those cases wherein the preamble gave meaning to latter elements of the claim. In Eaton Corp. v. Rockwell International Corp., 66 USPQ.2d 1271 (Fed. Cir. 1985) the preamble of a method claim for operating a truck transmission in two steps was limiting, because the steps described in the body of the claim could not be interpreted without reference to the structure provided in the preamble of the claims.

In composition claims the preamble must “breathe life” and meaning into the claims in order for a proper claims construction can lead to a conclusion that the preamble contains a necessary limitation to the claims. See Loctite Corp. v Ultraseal Ltd. 228 USPQ 90 (Fed. Cir. 1985). In that case the term “anaerobic curing” was in the preamble of a claim to a composition that would polymerize to a solid state in the absence of air. The use of the term “anaerobic” in the preamble was considered a limitation. In other words, if the preamble contains language that helps distinguish the claimed invention from the prior art, then the preamble is essential to the description of the invention and constitutes a limitation in the claims.

A summary of the law with respect to the issue of whether the preamble of the claim constitutes a limitation is found in Pitney Bowes, Inc. v. Hewlett Packard Co. 51 USPQ 2d 1161 (Fed. Cir. 1999). Summarizing the principle applied in that case, the Federal Circuit stated that when a preamble sets forth only the purpose or intended use of the invention, without adding to the description of the invention in the body or providing any definition of a limitation in the body, then the preamble plays no role in the claim’s construction.

In the present case the only mention of “phosphate ester based aircraft hydraulic fluid” is in the preamble of the claims and is in an expression of intended use. As now claimed, there is no need to refer to the preamble understand the scope and content of the components of the claimed composition. In the newly entered claims, the preamble is merely descriptive of the intended use and is not needed to understand or “breathe life” into the body of the claims as was observed in the Pitney Bowes case cited above. Accordingly, the claim construction applied to these claims by the Examiner in order to base the rejection on the Recapture Rule is not proper

according to the legal precedent of claim construction. Thus, the Examiner is respectfully requested to withdraw the rejection of the claims on the basis of the recapture rule.

#### **Claim Rejections Under 35 U.S.C. 103.**

The Examiner has rejected claims 107-109, now claims 131-152, under 35 U.S.C. 103(a) as being unpatentable over MacKinnon et al, U.S. 4,206,067 (hereinafter "MacKinnon") in view of Smith, U.S. 3,679,587 (hereinafter referred to as "Smith"). This rejection is traversed for the following reasons. Starting with the invention claimed herein, it is noted that the combination of ingredients of the additive package now claimed forms a composition that has provided surprising results with respect to the properties of phosphate ester based hydraulic fluids. As has been noted a few times in the record of this application such additive package has been regarded as novel by the inventors upon the filing of the original application.

Thus, the combination of ingredients of the claimed additive package has provided surprisingly improved results as has been shown by evidence in the record of this application. Such evidence of unexpected results is contained in the data filed with the earliest application in the record or this application as pointed out by the Revised Declaration of the inventor Gerbrand Deetman, dated February 11, 1999, and the second Declaration of Dr. Terry C. Wolfe, dated February 18, 1999. In these declarations, the unexpected results with regard to the claimed additive package in different phosphate ester hydraulic fluids is pointed out. Such results, among others, is the improved stability of the hydraulic fluid whether of the preferred alkyl C4 or C5 substituents of the phosphate esters or of the prior art alkyl phosphate esters. Such results are of

the type termed “unexpected” and “surprising”. Such results lend patentability to the claimed novel additive package.

While the Examiner points out the various components of the claimed additive package in the various prior art documents (MacKinnon and Smith) there is no indication that the combination now claimed would provide the results now shown to be obtained by the claimed composition. It is convenient to peruse the prior art, picking out the bits and pieces of the claimed composition having knowledge of the invention. However, such is not the position of the inventor. Such combination of art now made by the Examiner is in hindsight, having knowledge of the invention. More properly, the invention must be considered as a whole, rather than as a list of compounds gathered from various pieces of prior art. For example, Mackinnon discloses a prior art anti-erosion agent that can be improved by the addition of a high-boiling organic base. To reconstruct the presently claimed composition one of ordinary skill must delete the perhalometallic or perhalometalloidic acid that formed the starting point of Mackinnon disclosure. Thus adding the organic base without the anti-corrosion agent of Mackinnon would not seem “obvious”. Such mental calculations of subtraction and addition of components may seem “obvious” in hindsight but from the stand point of invention not only must the inventor make independent decisions with respect to each such addition and subtraction but also find the rest of the composition that provided unexpected results.

Although all of the precedents with respect to this type of rejection are too long to repeat here, the most often cited decision of the Court of Appeals for the Federal Circuit in this situation is In re Papesch, 137 USPQ 43 (Fed. Cir. 1963) (hereinafter “Papesch”). While that decision

concerned chemical compounds that were rejected as obvious, such reasoning is applicable here with respect to chemical compositions. The below quoted portion of the opinion by Judge Rich in Papesch summarizes the reasoning that provided the basis for finding an otherwise “obvious” invention to be “non-obvious”.

“From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing; graphic formula, chemical nomenclature, systems of classification and study such as concepts of homology, isomerism, etc., are mere symbols by which compounds can be identified, classified, and compared; but a formula is not a compound and, while it may serve in a claim to identify what is being patented, the thing that is being patented is not a formula but a compound identified by it. Patentability of the thing does not depend on similarity of the former compound to the latter; there is no basis in law for ignoring any property in making such a comparison; an assumed similarity based on comparison of formulae must give way to evidence that the assumption is erroneous.” (Emphasis added.)

In the present application there is ample evidence of surprising, unexpected results obtained by the use of the claimed additive package in phosphate ester hydraulic fluids i.e., its properties. There is nothing in the prior art that would suggest the improvements now found by the present Applicant in the claimed compositions. The Papesch precedent has been followed in like circumstances in areas of chemical invention other than compounds. See for example In re Otto Von Schichk, 150 USPQ 300 (Fed.Cir. 1966) (hereinafter “Schichk”). The invention involved in that decision was a chemical process that provided an increase in yield. A rejection for obviousness was overcome on the basis of the unexpected result. The opinion stated in part as follows:



“We find no suggestion of this characteristic [increased yield] of the claimed process. It appears to be quite unexpected and, being part of the invention as a whole, it should be treated under the law as is an unexpected property in compositions.”

The Schickh opinion then cited the Papesch decision as precedent for the conclusion of non-obviousness with respect to the claimed process. Recently, in August, 2007, the CAFC again followed this precedent and cited Papesch in its decision In re Sullivan, 84 U.S.P.Q.2<sup>nd</sup> 1034, 1040 (Fed. Cir. 2007) (hereinafter “Sullivan”), involving an invention claiming an antivenom composition. Accordingly, the remarkable and unexpected improvements that can be obtained by use of the claimed composition herein is part of the composition just as was the unexpected property of the compound in Papesch, the process in Schickh and the composition in Sullivan.

Accordingly, there is ample evidence in the record of this application with respect to the unexpected properties of the composition now claimed and the rejection under 35 U.S.C. 103(a) is respectfully requested to be withdrawn.

The Examiner has rejected claims 107-130 under 35 U.S.C. 103(a) as being unpatentable over MacKinnon in view of Smith and further in view of Great Britain 1,370,728 (hereinafter referred to as the “British patent”) and French patent 2,120,127 (hereinafter referred to as the “French patent”). This rejection is traversed for the following reasons.

The above remarks with respect to the MacKinnon and Smith references (particularly directed to Papesch and Schickh) are repeated here. These precedents are similarly applicable to the British and French patents.

With respect to the British patent it is noted that the point of the disclosure is the “synergistic” combination of hydrogen phosphates and certain hindered phenols. As noted above, one of ordinary skill in the art would have to pick and chose ingredients while leaving out others. Thus there would be no more obviousness in choosing hindered phenol than eliminating the hydrogen phosphate. One of ordinary skill has no basis to select one and not the other. As noted above, in hindsight, the process of reconstructing the invention from the prior art can be performed by picking and choosing selectively. However, prior to the invention this is not possible since there is no suggestion in the prior art to guide the inventor in the selection process other than test results generated by the inventor. The suggestion that the British patent renders the hindered phenol obvious ignores the fact that such hindered phenol of the prior art is combined with another agent that is not now present in the claimed novel additive package. The novel combination of the claimed additive package is the invention, not that each component was unknown for use in phosphate ester hydraulic fluids. The French patent narrowly discloses phosphate ester fluids but adds nothing to the accumulated prior art selected on the basis of the present disclosure. Particularly in view of the decision of In re Papesch, the facts of record clearly indicate the patentability of the claimed additive package over the accumulated pieces of the prior art assembled by the Examiner after having the advantage of the information contained in the present application. The objective evidence present in

the application provides the evidence of patentability as was found in Papesch and Schickh as noted above. The invention is not a list of ingredients but also encompasses the properties of the combination so as to provide a clear record of objective evidence of patentability. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 USC 103(a) on the basis of these four references.

The Examiner has rejected claims 107-130 under 35 U.S.C. 103(a) as being unpatentable over Skydrol® LD-4, Table 11, columns 35 and 36 of the present specification, in view of MacKinnon US 4,206,067 and further in view of Great Britain 1,370,728 and French patent 2,120,127. This rejection is respectfully traversed for the following reasons.

The above remarks with respect to MacKinnon, Smith as well as the British and French patents, particularly with respect to the objective evidence of invention are repeated here. The reference to the prior art hydraulic fluid LD-4 in table 11 is not available to the Examiner as it is Applicants own data disclosed only in the present application. It was noted in the Deetman Declaration of February 11, 1999, referred to above, the purpose of tables 11 and 12 added to the application July 28, 1993 as a continuation-in-part "incorporated additional experimental data into the specification to further demonstrated the patentability of the claimed functional fluid compositions." Of course, such data also provides objective evidence of patentability of the presently claimed combination of additives. As was further noted in the Deetman Declaration, "In Table 11, formulations 1 and 2 show substantially improved thermal stability when

compared to the prior art Skydrol® LD-4 formulation ('551 patent, Col. 37)". In other words, the purpose of presenting the data in Table 11 was to show the unexpected improvement in the use of the presently claimed additive package in the prior art LD-4 fluid. There is no admission that the LD-4 formulation in Table 11 containing the additive package now claimed was prior art. Quite to the contrary, Table 11 was submitted as objective evidence of invention to support the patentability of the now claimed additive package. In order to show the surprising result of improving not only the advanced, less toxic phosphate ester fluid in Table 11, the present inventive additive package was combined with the phosphate esters of the LD-4 fluid to show the surprising improvement in the thermal stability of such prior art phosphate esters.

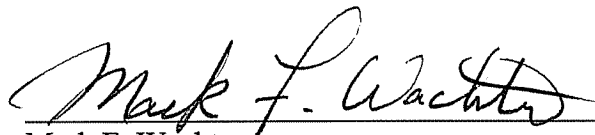
The data in Table 11 is not prior art, but is actually data produced by the inventor for the purpose of providing evidence of a surprising result with respect to the presently claimed additive package. The Deetman Declaration explains use of the claimed additive package with the LD-4 fluid and is not, in any way an admission that such additive package is prior art to the present application. In this instance the Examiner is using the information found only in the present application against the Applicant. Accordingly, the Examiner is respectfully requested to withdraw the rejection based upon any admission by patentee in US 5,464,551, particularly in view of the lack of combinability of the references upon which the rejection is based.

Application of: Gerbrand Deetman  
Serial No.: 09/801,883  
Amendment D

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date: Oct. 5, 2007

A handwritten signature in cursive script, reading "Mark F. Wachter", written over a horizontal line.

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*APPENDIX I*

**CORRESPONDENCE BETWEEN THE CANCELLED CLAIMS 107-130 AND NEW  
CLAIMS 131-152**

<u>NEW CLAIMS</u>	<u>PREVIOUS CLAIMS</u>
131	107
132	110
133	111
134	112
135	113
136	114
137	115
138	116
139	117
140	118
141	119
142	120
143	121
144	122
145	123
146	124
147	125
148	126
149	127
150	128
151	129
152	130